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The time period for reply, if any, is set in the attached communication.

1 RECORD OF ORAL HEARING
2 UNITED STATES PATENT AND TRADEMARK OFFICE
3

4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7 *Ex Parte* YOUNGER AHLUWALIA, MATTI KIIK,
8 and THOMAS D. KAROL
9

10 Appeal 2010-004933
11 Application 10/766,654
12 Technology Center 1700
13

14 Oral Hearing Held: January 12, 2011
15

16 Before CHARLES F. WARREN, JEFFREY T. SMITH, and KAREN M.
17 HASTINGS, *Administrative Patent Judges.*

18 APPEARANCES:

19 ON BEHALF OF THE APPELLANT:

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24 The above-entitled matter came on for hearing on Wednesday,
25 January 12, 2011, at the U.S. Patent and Trademark Office, 600 Dulany
26 Street, Alexandria, Virginia, before Timothy J. Atkinson, Jr., a Notary
 Public.

PROCEEDINGS

2 JUDGE WARREN: Is this gentleman a guest of yours?

3 MR. MURNANE: No, Your Honor.

4 UNNAMED MAN: I have the next hearing. I was just observing.

5 JUDGE WARREN: That's fine, if you have no objection.

6 MR. MURNANE: I don't, Your Honor.

7 JUDGE WARREN: We are commencing a hearing on Appeal

8 Number 2010-004933.

9 MR. MURNANE: Thank you, Your Honor.

10 JUDGE WARREN: You may begin when ready, sir.

11 MR. MURNANE: Thank you, Your Honor. May it please the Court,

12 I'd like to begin discussing the claims here, the first two claims, the

13 independent claims. First, a heat-insulating and fire-resistant composite

14 material consisting essentially of a first layer, which comprises a surfactant

15 component, surfactant generated microcells, a filler component and a binder

16 component and a second layer comprising a metallic component adhered to

17 the first layer. There is no substrate that's noted in claim 1.

18 JUDGE WARREN: But claim 1 can include a substrate?
19 MR. MURNANE: We disagree, Your Honor. We note that this is the
20 big point here and we --

21 JUDGE WARREN: Well, one of the things I wanted to ask you

21 JUDGE WARREN: Well, one of the things I wanted to ask you,
22 counselor, was if you look at the specification, paragraphs 21, 23 and 26, it
23 would appear to indicate that the basic and novel characteristics of your
24 invention are not compromised by the presence of a substrate.

25 MR. MURNANE: I wouldn't say they are compromised, but I think
26 we have different inventions. Your Honor. If I may invite attention to the

1 specification, page 15, paragraph 45, the last sentence says the substrate
2 provides strength for the composite material. And I would also invite
3 attention to page 23, paragraph 66, where it says when a substrate is
4 employed the first layer may be adhered on one side or both sides of the
5 substrate, depending on the intended application. For instance, if one side of
6 the substrate is coated with at least -- to at least some extent with the first
7 layer, and the second layer comprised the metallic component, then the other
8 surface may be covered to at least some extent with another material. In the
9 roofing materials industry, for example, the other material may be
10 conventional roofing asphalt, modified asphalts, and nonasphaltic coatings
11 and the article can then be topped with roofing granules. If we take --

12 JUDGE WARREN: But the term consisting essentially of itself is not
13 defined in your spec.

14 MR. MURNANE: We believe, Your Honor, when we look at the
15 specification as a whole, the entirety of the specification, and we see the
16 many different products that can be made with the claimed invention, we see
17 that there are varieties of products. It talks about fabrics, it talks about
18 building materials, and here I gave an example of roofing materials. It is
19 noted that the substrate provides strength for the composite material. I think
20 this specification describes the elegant efforts of the inventors to provide
21 flexibility for those of skill in the art who wish to read this disclosure and
22 then make different kinds of materials. Perhaps they're going to be making
23 fabrics. Perhaps they're going to be making mattress ticking. Sometimes,
24 strength may be more important in some instances than in another. And so,
25 it's our view, Your Honor, that we really do have two inventions here, and
26 with the wide variety of environments in which the invention can be used, it

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1 may be sometimes you want that strength and other times perhaps flexibility
2 and pliability would be more important.

3 Now, Your Honor, the Examiner has noted in the Answer, in the
4 paragraph bridging pages 3 and 4, that the Ahluwalia teaching, the prior art
5 Ahluwalia teaching, the '257 teaching, taught the use of a binder, including
6 an acrylic latex, such as hi carb 2679. And the Examiner notes, it should be
7 noted that hi carb 2679 polymer emulsion contains synthetic soap,
8 sometimes known as surface active agents or surfactants, thus meeting
9 Applicants' limitation of a surfactant component. Furthermore, because a
10 surfactant is present in Ahluwalia's composition, surfactant generated
11 microcells would also be present. With that construction, Your Honor,
12 assuming that's the construction to be given to these claims, if we take that
13 construction and say that's the construction of the claims, then claim 2 of
14 this application is, essentially, the same claimed subject matter of claim 1 of
15 the application we spoke about earlier this morning, Your Honor. And so
16 we would submit -- and these cases were filed on the same day -- when the
17 patents issue, should they issue and, hopefully, they will, they will have the
18 same term. This claim 2 is really the same claimed subject matter as the first
19 claim of the case we talked about earlier today, and so we would submit all
20 the arguments presented there should obtain for this as well, Your Honor.
21 The same prior art is cited against it.

22 JUDGE WARREN: Did you have the same showing in your case
23 here?

24 MR. MURNANE: We don't have in the specification the same
25 showing. Again, if the Office takes the position that the claimed subject
26

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1 matter of claim 2 is identical to the claimed subject matter of claim 1 of the
2 prior case, we would submit that the same unexpected results should apply.

3 JUDGE WARREN: You still have to have basis in the record of all
4 that. What defends your position, counselor?

5 MR. MURNANE: Thank you, Your Honor, and with respect to claim
6 1, we do believe claim 1 is distinguishable for the reasons noted in our prior
7 colloquy, Your Honor. It is different. We believe that --

8 JUDGE WARREN: We're not saying that it has to have a substrate,
9 we're just saying you have several different embodiments there, one of
10 which can have a substrate.

11 MR. MURNANE: Thank you, Your Honor. And as we noted on
12 page 2 of our Reply Brief, you know, we believe, that there are -- by the
13 way, there's a typo there and I apologize, Your Honor. That refers to page
14 5, paragraph 15 of our spec. It should been have been page 15, paragraph
15 45. I apologize for the error, Your Honor. And again, the same points that
16 we made with respect to the other case with respect to Komatsu and the
17 criteria that the Federal Circuit established there and the distinctions with
18 respect to Langer, the British '060, Dugan and Dombeck. We would say
19 they all apply, Your Honor.

20 JUDGE WARREN: Okay.

21 MR. MURNANE: I have nothing further on this, Your Honor. I
22 would entertain any questions.

23 JUDGE WARREN: Thank you very much, counselor.

24 MR. MURNANE: Thank you very much, Your Honors.

25 (Whereupon, the proceedings were concluded.)

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